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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/476,291	12/30/1999	CRAIG S. RANTA	MICR0230	7623

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EXAMINER

CHUNG, JASON J

ART UNIT PAPER NUMBER

2611

DATE MAILED: 07/14/2004

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/476,291

Applicant(s)

RANTA, CRAIG S.

Examiner

Jason J. Chung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 6/7/04 have been fully considered but they are not persuasive.

The applicant argues on pages 4-8 of the response that Williams does not disclose a menu of coupon categories. The applicant argues on pages 11-12 of the response that the menu of coupon categories is not equivalent to a preference profile. The examiner respectfully disagrees with this assertion. Since there is a disagreement between the applicant and the examiner as to whether the menu of coupon categories is equivalent to the preference profile, the examiner has decided to read the claims in light of the specification to determine the meaning of the menu of coupon categories. Page 8, lines 2-11 of the applicant's specification states that coupons that COMPORT (corresponds) with the users selections are stored. Furthermore, page 11, lines 3-11 of the applicant's specification recite similar language. According to the applicant's specification, the coupons that correspond to the user's preferences are stored, then the user can further decide whether or not they want the coupons. Williams discloses the entertainment preferences of network users of a network are observed and recorded by the client for determining a target audience to which coupons are delivered and the users may disclose various preferences as part of registering with the network and the profiles are compiled and generated (column 5, line 63-column 6, line 12). Williams continues by disclosing the preferences that the user sets include sports, activities, television programming, etc. (column 6, lines 13-24), which meets the limitation on configured to selectively respond to actuation by a user and the limitation of enabling a user to selectively manipulate a setup mode prior to the transmission session and

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the controller responding to the selection of the setup mode by causing a menu including a plurality of different coupon categories to be presented to the user on the display. The examiner takes the read of the selection of the coupon categories is done via the user creating the preference profile; furthermore, Williams discloses the client side filtering is done based on the preference profile (column 6, lines 49-56). Thus, after reading the claims in light of the specification, the examiner interprets the reference of Williams to meet the claimed limitation and that the menu of coupon categories in the applicant's specification is no different than the preference profile in the Williams reference in that they both use filtering the coupons based on a user's taste such that coupons that CORRESPOND to the user's taste are stored. The examiner takes a broader read of the claimed invention. The examiner interprets the completion of the preference profile to read on a menu of different categories where the menu is just a user identifying likes and dislikes. Furthermore, the reference of Williams discloses configuring a GUI that presents the entertainment system information (column 5, lines 4-20; figure 2), which places the reference of Williams in a computer environment. Thus, the presence of a GUI necessitates a list (menu) of items that the user can indicate what he/she likes.

The applicant argues on page 6, lines 1-13 that there is no evidence provided that would lead one of ordinary skill in the art to understand that when a user indicates a preference, the user has actually affirmatively elected to receive advertising (coupon) information related to the category. The examiner respectfully disagrees with that assertion and has taken a broader interpretation than that of the applicant. Although the examiner is not debating the logic of that statement, the claimed invention does not recite those limitations. When the user, for the first

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time, is selecting coupon categories, he/she is not affirmatively aware that they have elected to receive advertising (coupon) information related to the category.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the user being aware they are receiving advertising (coupon) information related to a category) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The applicant argues on page 6, lines 14-30 of the response that the user cannot change the preference profile. The examiner used the recitation of Williams (column 6, line 7) in the advisory action to support the previous stance, however, the examiner withdraws the previous stance made in the advisory action. Although the examiner is not debating the logic of the argument made, the claimed invention does not recite those limitations. The applicant believes the claims enable the user to change the preference profiles. The examiner respectfully disagrees with that assertion. The claims are broad enough to mean that the preference profile is established **once** prior to the transmission of coupons.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the user being able to change the preference profile more than once) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The applicant argues on page 7, lines 1-20 of the response that just because a user has interest in a certain activity or topic doesn't mean that the person wants or needs to receive coupons related to that interest, and similarly people need products or services outside their interests. The examiner respectfully disagrees with that assertion and has taken a broader interpretation than that of the applicant. Although the examiner is not debating the logic of that statement, the claimed invention does not recite those limitations.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the user receiving products or services unrelated to their interests) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The applicant argues on pages 8-9 of the response that the prior rejection does not meet the limitation on the integral decoder. The examiner respectfully disagrees with this assertion. Mankovitz discloses the controller can be connected to the electronic coupon via a hard wire 18, 20 or IR emitter (column 3, lines 44-62 and column 6, lines 53-58). Mankovitz discloses the decoder 50 is part of the controller (column 6, lines 30-39). Mankovitz discloses the controller 12 (decoder) can have a moiety connector 18 and receive a second moiety connector 20 of the coupon (column 3, lines 44-62; figure 1a), which meets the limitation on the decoder, display, the at least one control key, the memory, and the processor being encompassed in a common housing. Thus, once the coupon is inserted into the decoder, they are in a common housing.

Applicant's arguments, see pages 10-11 of the response, filed 6/7/04, with respect to the rejection(s) of claim(s) 9, 10, 26, 29, 31 under section 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of a new statement of obviousness.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-27, 29, 31 rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (US Patent # 6,075,971) in view of Mankovitz (US Patent # 5,523,794) in view of Small (US Patent # 5,808,689) in further view of Terrill (US Patent # 6,052,755).

Regarding claim 1, page 8, lines 2-11 of the applicant's specification states that coupons that COMPORT (corresponds) with the users selections are stored. Furthermore, page 11, lines 3-11 of the applicant's specification recite similar language. According to the applicant's specification, the coupons that correspond to the user's preferences are stored, then the user can further decide whether or not they want the coupons. Williams discloses the entertainment preferences of network users of a network are observed and recorded by the client for determining a target audience to which coupons are delivered and the users may disclose various preferences as part of registering with the network and the profiles are compiled and generated (column 5, line 63-column 6, line 12). Williams continues by disclosing the preferences that the

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user sets include sports, activities, television programming, etc. (column 6, lines 13-24), which meets the limitation on configured to selectively respond to actuation by a user and the limitation of enabling a user to selectively manipulate a setup mode prior to the transmission session and the controller responding to the selection of the setup mode by causing a menu including a plurality of different coupon categories to be presented to the user on the display. The examiner takes the read of the selection of the coupon categories is done via the user creating the preference profile; furthermore, Williams discloses the client side filtering is done based on the preference profile (column 6, lines 49-56). Thus, after reading the claims in light of the specification, the examiner interprets the reference of Williams to meet the claimed limitation and that the menu of coupon categories in the applicant's specification is no different than the preference profile in the Williams reference in that they both use filtering the coupons based on a user's taste such that coupons that CORRESPOND to the user's taste are stored. The examiner takes a broader read of the claimed invention. The examiner interprets the completion of the preference profile to read on a menu of different categories where the menu is just a user identifying likes and dislikes. Furthermore, the reference of Williams discloses configuring a GUI that presents the entertainment system information (column 5, lines 4-20; figure 2), which places the reference of Williams in a computer environment. Thus, the presence of a GUI necessitates a list (menu) of items that the user can indicate what he/she likes.

Williams discloses that the servers provide coupons may broadcast coupons over the network and the coupons are filtered based on preference profiles compiled by the client to be redeemed by the user (column 6, lines 49-56), which meets the limitation on enabling the user to manipulate the control key to select at least one of the different coupon categories and the

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limitation on automatically analyzing the extracted coupon data produced by the decoder such that only coupons defined by the extracted coupon data that correspond to the at least one of the different coupon categories selected by the user in the setup mode are automatically stored in the non-volatile memory and each coupon defined by the extracted coupon data that does not correspond to the at least one of the different coupon categories by the user are automatically discarded. As disclosed, Williams discloses transmitting a plurality of coupons.

Williams discloses that the coupons may be delivered by the VBI and/or cable broadcast, or by UHF, and/or VHF (column 6, lines 66-67). Williams fails to disclose the decoder and the controller. Mankovitz discloses electronic coupon data is transmitted in the VBI of a television signal (column 5, lines 26-50). Mankovitz discloses encoded data is extracted from the VBI using a VBI decoder (column 2, lines 24-39), which meets the limitation on a decoder configured to receive a video signal during transmission session and to extract coupon data from the video signal producing extracted coupon data.

Mankovitz discloses electronic coupon information is displayed (column 5, lines 46-56), which meets the limitation on a displayed that displays coupons defined by the extracted coupon data.

Mankovitz discloses a microprocessor 35 (controller) (figure 2) that is coupled to RAM (storage) 36 and a liquid crystal display (column 4, lines 13-28), which meets the limitation on a controller being coupled to the storage and a display.

Additionally, Mankovitz discloses the read key that lets the user decide what they want to do with the data (column 3, line 63-column 4, line 7). Mankovitz discloses the read key lets the user determine, whether to save the coupon for later redemption (column 5, line 57-column 6,

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line 5). Mankovitz discloses the save key being pressed, the coupon data is saved for later redemption (column 5, line 57-column 6, line 5). Mankovitz discloses the shift key or predetermined keystrokes may be used to redeem the coupons (column 5, lines 41-55); the keys meet the limitation on a plurality of control keys.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Williams to have a decoder and controller as taught by Mankovitz in order to strip the data from the VBI of the television signal.

As previously disclosed, both Williams and Mankovitz discloses the coupon data is transmitted in the VBI of a television signal. Neither Williams nor Mankovitz discloses the coupon data in the horizontal overscan. Small discloses transmitting data in the horizontal overscan portion of a television signal to avoid interfering with the blanking intervals in order to avoid 60-cycle hum problems (column 3, lines 34-57 and column 5, lines 24-36). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Williams in view of Mankovitz to have the data in the horizontal overscan instead of the VBI as taught by Small in order to avoid interfering with the closed captioning signal.

As previously disclosed, Mankovitz discloses the coupons are stored in a RAM (volatile memory) (column 4, lines 12-18 and column 4, lines 35-53). Neither Williams, Mankovitz, nor Small discloses a non volatile memory. Terrill discloses a RAM, ROM, magnetic **and/or** optical media and the like are interchangeable. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mankovitz to have a ROM (non volatile memory) or any other type of memory instead of a RAM as taught by Terrill in order to give more system versatility.

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Regarding claim 2, Mankovitz discloses the controller can be connected to the electronic coupon via a hard wire 18, 20 or IR emitter (column 3, lines 44-62 and column 6, lines 53-58). Mankovitz discloses the decoder 50 is part of the controller (column 6, lines 30-39). Mankovitz discloses the controller 12 (decoder) can have a moiety connector 18 and receive a second moiety connector 20 of the coupon (column 3, lines 44-62; figure 1a), which meets the limitation on the decoder, display, the at least one control key, the memory, and the processor being encompassed in a common housing.

Regarding claim 3, Mankovitz discloses the portable data coupon includes a display (column 3, lines 63-65). Mankovitz discloses the display is a LCD (column 4, lines 18-27).

Regarding claims 4-5, Mankovitz discloses the coupon is displayed as an UPC code (column 8, lines 10-23). Mankovitz discloses the coupon is called up in an UPC code and it is scanned at a cash register (column 8, lines 23-41), which meets the limitation on the UPC being read by a bar code scanner.

Regarding claim 6, as disclosed in claim 1 rejection, Williams, Mankovitz, and Small discloses television broadcast.

Regarding claim 7, Mankovitz discloses the television broadcast comprises commercials (column 5, lines 26-35).

Regarding claim 8, Mankovitz discloses the decoder used in a VCR to perform the functions (column 6, lines 18-28 and column 7, lines 5-12), which meets the limitation on transmission comprises a playback of a video taped program.

Regarding claims 9-10, the claim states at least one control key, which means more than one key can be used. Williams meet the limitation on the storing the selected coupon that

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corresponds to the category in claim 1 rejection. Williams discloses the user creates a preference profile prior to the transmission of the signal as disclosed in claim 1 rejection, which meets the limitation on a control key comprising a mode key the limitation of further comprising a selecting the setup mode in claim 10 of the application. Williams discloses the client system may filter out the coupons that satisfy the preference profile (column 6, lines 49-56), which meets the limitation on a storage mode enables the controller to analyze extracted coupon data and saves coupons corresponding to a selected coupon category. Mankovitz discloses the read key that lets the user decide what they want to do with the data (column 3, line 63-column 4, line 7). Mankovitz discloses the save key being pressed, the coupon data is saved for later redemption (column 5, line 57-column 6, line 5), which meets the limitation on a storage mode. Mankovitz discloses the shift key or predetermined key strokes may be used to redeem the coupons (column 5, lines 41-55). Mankovitz discloses a coupon is displayed to the user (column 5, lines 26-56). Mankovitz discloses the coupons are called to the display when the user is making purchases (column 8, lines 24-40), which meets the limitation on when in redeem mode, displaying a menu of each of the coupons.

Neither Williams, Mankovitz, Small, nor Terrill discloses a single button that can perform multiple functions. The examiner takes Official Notice that a button that can perform a plurality of options is notoriously well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Williams in view of Mankovitz in further view of Small in further view of Terrill to a button that can perform a choice of a plurality of options in order to increase functionality of the system by simplifying operations.

Regarding claims 11-12, Terrill discloses a RAM, ROM (electrical circuit), magnetic **and/or** optical media and the like are interchangeable.

Regarding claims 13-19 the limitations in claims 13-19 have been met in claims 1, 6, 8-10 rejections.

Regarding claims 20-21, the limitations in claims 20-21 have been met in claims 4-5 rejections.

Regarding claims 22-23, the limitations in claims 22-23 have been met in claims 11-12 rejections.

Regarding claim 24, 26, 27, 29, 31 the limitations in claims 24, 26, 27, 29, 31 have been met in claims 1, 9 rejections.

Regarding claim 25, the limitations in claim 25 have been met in claim 11 rejection.

2. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz in view of Small.

Mankovitz discloses the portable coupon data 10 can join the controller 12 (figure 1) with connectors 18, 20 or with a wireless interface (column 3, lines 44-62). The combination of the portable coupon data 10 and the controller 12 reads on the electronic coupon. Mankovitz discloses coupon data is transmitted in the VBI of a television signal (column 5, lines 26-50). Mankovitz discloses encoded data is extracted from the VBI using a VBI decoder (column 2, lines 24-39), which meets the limitation on providing an electronic coupon including a decoder configured to extract coupon data from the video signal and the limitation on extracting coupon data from the video signal using the decoder in the electronic coupon.

Mankovitz discloses the read key that lets the user decide what they want to do with the data (column 3, line 63-column 4, line 7). Mankovitz discloses the read key lets the user determine, whether to save the coupon for later redemption (column 5, line 57-column 6, line 5). Mankovitz discloses the save key being pressed, the coupon data is saved for later redemption (column 5, line 57-column 6, line 5), which meets the limitation on storing the coupon data extracted by the decoder in the electronic coupon.

As previously disclosed, Mankovitz discloses the coupon data is transmitted in the VBI of a television signal. Mankovitz fails to disclose the coupon data in the horizontal overscan. Small discloses transmitting data in the horizontal overscan portion of a television signal to avoid interfering with the blanking intervals in order to avoid 60-cycle hum (column 3, lines 34-57 and column 5, lines 24-36). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mankovitz to have the data in the horizontal overscan instead of the VBI as taught by Small in order to avoid interfering with the closed captioning signal.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason J. Chung whose telephone number is (703) 305-7362. The examiner can normally be reached on M-F, 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JJC



VIVEK SRIVASTAVA
PRIMARY EXAMINER